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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,211	10/23/2001	Arnold W. Fogel	B30-050	2238
7590 01/22/2004				
Henry D. Coleman Coleman Sudol Sapone, P.C. 714 Colorado Avenue Bridgeport, CT 06605-1601			EXAMINER HUI, SAN MING R	
			ART UNIT 1617	PAPER NUMBER

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/045,211

### Applicant(s)

FOGEL, ARNOLD W.

### Examiner

San-ming Hui

### Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
od for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### tus

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2003 has been entered.

Applicant's remarks filed October 20, 2003 have been considered, and are found persuasive to withdraw the outstanding rejection under 35 USC 112, second paragraph.

Claims 1-36 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1617

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fogel (US Patent 6,126,949 from the IDS received June 11, 2002), Herstein (US Patent 5,902,591), and McCutcheon (McCutcheon's Emulsifiers & Detergents North American Edition, 2000, 2000, page 18), references of record.

Fogel teaches the instant component A, a dialkyl fumarate, especially dibehenyl fumarate, is useful in harden or stiffen any cosmetically acceptable oil or water-in-oil emulsions and to enhance the stability of water-in-oil emulsion (See particularly the abstract). Fogel also teaches the emollients may be used with dibehenyl fumarate as petrolatum, mineral oil, various vegetable oils such as sunflower oil and safflower oil, and neopentanoates such as octyl dodecyl neopentanoate (See col. 3, line 65 - col. 4, line 59; also col. 10, line 64 in example 5). Fogel also teaches that the water-in-oil emulsion may contain 20-25% to 55-60% of water and 40-45% to 75-80% of emollient oil (See col. 5, line 31-33). Fogel also teaches that nonionic emulsifiers may be used in the water-in-oil emulsion (See col. 6, line 25).

Herstein teaches that a 5-10% of vitamin C containing topical cosmetic composition employing several preferred emulsifiers: one of which is stearic monoethanolamide (the instant preferred component C) (See the abstract and also col. 5, line 23).

McCutcheon teaches the Arlacel P135, the instant preferred component B, is useful as an emulsifier for cosmetic use (See page 18, col. 2).

Art Unit: 1617

The references do not expressly teach the three components can be incorporated into a single composition. The references do not expressly teach the specific weight ratio of the three components as 1-15% of component A, 1-15% of component B; and the ratio among components A, B, and C as 1:1:1 or 3:2:3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the three components herein into a single composition in the weight ratio herein.

One of ordinary skill in the art would have been motivated to incorporate the three components herein into a single composition in the weight ratio herein because component B and C are known, based on the cited prior art, to be useful as emulsifiers in water-in-oil emulsion. Combining two agents, which are known to be useful as emulsifiers individually into a single composition useful for formulating an emulsion composition, is *prima facie* obvious. See *In re Kerkhoven* 205 USPQ 1069. Moreover, dibehenyl fumarate, component A, is known to be useful to enhance the stability of water-in-oil emulsion. Therefore, further incorporating component A into the emulsion composition containing component B and C would have been reasonably expected to be useful in stabilizing the resulting emulsion composition. In addition, the optimization of result effect parameters (e.g., weight ratio or amount of the components) is obvious as being within the skill of the artisan, absent evidence to the contrary. No such evidence is seen herein.

It is applicant's burden to demonstrate unexpected results over the prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be

Art Unit: 1617

demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). In the instant case, no data was set forth in the specification for demonstrating the unexpected result. Therefore, no unexpected results are seen herein.

### ***Response to Arguments***

Applicant's rebuttal arguments filed October 20, 2003 averring the presence of unexpected benefits, i.e., superior stability, have been considered, but are not found persuasive. As discussed above, it is applicant's burden to demonstrate unexpected benefits. In the instant case, no data was set forth in the specification for demonstrating the unexpected result. Therefore, no unexpected results are seen herein. The claims are seen to be properly rejected under 35 USC 103.

Applicant's rebuttal arguments filed October 20, 2003 averring the specific ratio of the herein claimed components have been fully considered but they are not persuasive. As to the herein claimed weight percent, it is within the skill in the art to select optimal parameters such as ratios or weight percents of components in order to achieve a beneficial effect (See *In re Boesch*, 205 USPQ 215 (CCPA 1980)). Therefore, the ratio or weight percent herein claimed are not considered critical absent showing unexpected and superior results. Furthermore, since these components are

Art Unit: 1617

well known in the art to be emulsifier and stabilizer, the selection of one or another old and well known agents would be seen as a simple selection from among obvious alternatives, absent evidence to the contrary.

Applicant's rebuttal arguments filed October 20, 2003 averring the cited prior art's failure to teach the instant combination of emulsifiers have been considered, but are not found persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). All of the recited components are taught by the cited prior arts as emulsifiers. Possessing the teachings of the cited prior art as a whole, one of ordinary skill in the art would have motivated to combine these three well-known cosmetic emulsifiers into a single composition useful for the very same purpose, absent evidence to the contrary (See *In re Kerkhoven* 205 USPQ 1069).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 10/045,211

Page 7

Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "San-ming Hui", with a stylized flourish at the end.

San-ming Hui  
Patent Examiner  
Art Unit 1617